

REMARKS

Entry of this Amendment and reconsideration are respectfully requested in view of the amendments made to the claims and for the remarks made herein.

Claims 1-19 and 21-25 are pending and stand rejected

Claim 1 has been amended.

Claims 1, 19 and 25 are independent claim.

Claims 1-3, 6, 9-11, 14-19, 22, 23 and 25 stand rejected under 35 USC 102(e) as being anticipated by Edwards (USPPA 2006/0110568). Claims 4, 5, 21 and 24 stand rejected under 35 USC 103(a) as being obvious over Edwards in view of Tyan (USP 5,051,340). Claims 7-8 stand rejected under 35 USC 103(a) as being unpatentable over Edwards in view of Ota (USP no. 4,732,844). Claim 13 stands rejected under 35 USC 103(a) as being unpatentable over Edwards in view of JP 06-060440.

Claims 1-19 and 21-25 stand provisionally rejected on the ground of nonstatutory obviousness-type double patenting over claims 1-21 of co-pending Application no. 10/599,834.

Prior to commenting on the merits of the rejection of the claims in view of the Edwards reference, applicant would note that the instant application claims priority to PCT/IB05/051165 filed on April 8, 2005, which was published, in English, as WO2005/101398 on October 27, 2006 and designated the US. A certified copy of the priority document has been incorporated into the file wrapper.

In addition PCT/IB05/51165 claims priority to that application filed in the European Patent Office on April 4, 2004 and afforded serial number 04101564.5.

Pursuant to 35 USC §§102(e), 120, 351 and 363, the earliest filing date of the instant application is, thus, April 4, 2004.

Edwards, which was filed on November 23, 2004, was filed after the earliest filing date of the instant application and, thus, is not an appropriate prior art reference for rejecting the claims under 35 USC 102(e).

Applicant submits that because Edwards was filed after the earliest filing date to which the instant application properly claims priority, the rejection of the claims under 35 USC 102(e) is not valid.

Applicant respectfully requests that because all the claims are rejected based on the Edwards reference, all of the rejections should be withdrawn.

Notwithstanding the argument presented above, applicant respectfully disagrees with and explicitly traverses the rejection of the claims under 35 USC 102.

Edwards discloses a system for improving quality of a master used in data storage disk manufacturing, wherein a portable conformable mask is formed in a top layer and defining a feature of the master in a second layer through the portable conformable mask of the top layer. With reference to Figures 3A and 3B, Edwards describes a process wherein the top layer is photo-etched with a focused laser spot (see para. 0056) and then a reactive ion etching (RIE) method is used to further etch the second layer using the photo-etched first layer as a mask (see para. 0061). A similar process is described with regard to Figs. 4A-4E, wherein multiple layers are etched using the RIE method.

In Para. 0053, Edwards describes a condition wherein '[i]f both the second layer and the third layer comprise photoresist, the different photoresist layers may be sensitive to different wavelengths of light. In that case, different illuminating light can be used to define different photo-etching processes for the respective layers.

With reference to independent claims 19 and 25, applicant submits that the method recited teaches steps of rinsing the illuminated master substrate layer between the illumination steps.

Edwards fails to provide any teaching regarding rinsing the illuminated master substrate layer a first time, as is recited in independent claims 19 and 25. Furthermore Edwards fails to disclose any teaching regarding a step of sputter-deposition of a metallic layer or a step of galvanically growing the sputter-deposited layer, as is recited in the claims.

A claim is anticipated if and only if each and every element is recited in a signal prior art reference.

Thus, even if the Edwards reference could be considered a prior art reference under 35 USC 102(e), Edwards cannot be said to anticipate the invention recited in claims 19 and 25 as Edwards fails to disclose a material element recited in the claims.

For the remarks made herein, applicant submits that the reason for the rejection has been overcome.

With regard to the rejection of claim 1, this claim has been amended to further recite a rinsing step similar to that recited in claims 19 and 25. Accordingly, claim 1 is also not anticipated by Edwards for the same reasons presented with regard to claims 19 and 25.

For the amendments made to claim 1, applicant submits that the reason for the rejection of claim 1 has been overcome.

With regard to the remaining claims, these claims depend from the aforementioned independent claims and, hence, are also not anticipated by Edwards by virtue of their dependency upon allowable base claims.

With regard to the rejection of claims 4, 5, 21 and 24 under 35 USC 103(a) as being obvious over Edwards in view of Tyan, claims 7-8 under 35 USC 103(a) as being unpatentable over Edwards in view of Ota and claim 13 under 35 USC 103(a) as being unpatentable over Edwards in view of JP 06-060440, applicant respectfully disagrees with and explicitly traverses the rejection of the claims.

Tyan discloses a method for manufacturing a master of the replication of optical elements by focusing an information modulated energy beam on a phase change optical recording layer so as to form a pattern of two different phases in the layer and selectively etching away one of the two different phases so as to form a relief pattern.

Ota discloses a method for manufacturing an optic disk having both address pits and grooves having accurately controlled depths and widths using two different types of sensitive materials of different characteristics applied to a recording original board. Ota discloses using multiple etchings to create different regions –the address and the guiding grooves – in the recording material. The different photo materials are on the same level.

A claimed invention is *prima facie* obvious when three basic criteria are met. First, there must be some suggestion or motivation, either in the reference themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the teachings therein. Second, there must be a reasonable expectation of success. And, third, the prior art reference or combined references must teach or suggest all the claim limitations. The Court in KSR v. Teleflex (citation omitted) has held that the teaching, suggestion and motivation test (TSM) is merely to be used as a helpful hint in determining obviousness and a bright light application of such a test is adverse to those factors for determining obviousness enumerated in Graham v. John Deere (i.e., the scope and content of the prior art, the level of ordinary skill in the art, the differences between the claimed invention and the prior art and objective indicia of non-obviousness) (citation omitted).

In this case, the combination of the cited references, even if Edwards could be considered an appropriate prior art reference, fails to disclose a material element recited in each of the independent claims.

Accordingly, each of the aforementioned claims is not rendered obvious by the cited references.

With regard to the provisional rejection of claims 1-25 on the ground of nonstatutory obviousness-type double patenting over claims 1-21 of co-pending Application no. 10/599,834, applicant respectfully requests that the rejection be held in abeyance until such time that either the instant application or the referred-to application issues and the issued claims may then be compared to those of the remaining application to determine whether the rejection is still applicable.

For the amendments made to the claims and for the arguments presented herein, applicant submits that the rejections of the claims has been overcome and respectfully requests that the rejections be withdrawn. The issuance of Notice of Allowance in this matter is respectfully requested.

Applicant denies any statement, position or averment stated in the Office Action that is not specifically addressed by the foregoing. Any rejection and/or points of argument not addressed are moot in view of the presented arguments and no arguments are waived and none of the statements and/or assertions made in the Office Action is conceded.

Applicant makes no statement regarding the patentability of the subject matter recited in the claims prior to this Amendment and has amended the claims solely to facilitate expeditious prosecution of this patent application. Applicant respectfully reserves the right to pursue claims, including the subject matter encompassed by the originally filed claims, as presented prior to this Amendment, and any additional claims in one or more continuing applications during the pendency of the instant application.

In the event the Examiner deems personal contact desirable in the disposition of this case, the Examiner is invited to call the undersigned attorney at the telephone given below.

Respectfully submitted,
Michael E. Belk, reg. no. 33,357

Date: May _____, 2010

/Carl A. Giordano/

By: Carl A. Giordano
Attorney for Applicant
Registration No. 41,780

Mail all correspondence to:
Michael E. Belk, Esq.
US PHILIPS CORPORATION
P.O. Box 3001
Briarcliff Manor, NY 10510-8001
Phone: (914) 333-9643
Fax: (914) 332-0615

CERTIFICATE OF MAILING UNDER 37 C.F.R. §1.8(a)

The undersigned hereby certifies that this document is being:

- ☐ Transmitted electronic by the currently available EFS system;
☐ Transmitted by facsimile to 571 273 8300;
☐ Placed with the US Postal Service with First Class postage attached to the address indicated above;
on **May** ____ **2010**.

Print Name

Signature